

## **REMARKS**

1. In response to the Office Action mailed August 18, 2009, Applicant respectfully request reconsideration. Claims 12-30 were last presented for examination. In the outstanding Office Action, claims 12-30 were rejected. By the foregoing Amendments, claims 13 and 15-20 have been amended, claims 12, 14 and 21-30 have been cancelled, and claims 31-42 have been added. Thus, upon entry of this paper, claims 13, 15-20 and 31-43 will be pending in this application. Of these twenty (20) claims, two (2) claims (claims 31 and 36) are independent.
2. Based upon the following Remarks, Applicants respectfully request that all outstanding rejections be reconsidered and withdrawn.

### ***Claim Objections***

3. The Examiner has objected to claim 28 under 37 C.F.R. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. In response, in order to advance prosecution, and without prejudice or disclaimer, Applicant has cancelled claim 28, thereby rendering the objection moot.

### ***Claim Rejections under §112***

4. Claims 12-20 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, in order to advance prosecution, and without prejudice or disclaimer, Applicant has cancelled claim 12. In addition, the language identified in the Office Action as being indefinite is not present in any of the amended or new claims. The above amendments thereby render the rejection moot.

### ***Claim Rejections under §102 - Lenhardt***

5. The Examiner has rejected claims 21-26, 28 and 30 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,047,994 to Lenhardt et al. (hereinafter, "Lenhardt"). In response, in order to advance prosecution, and without prejudice or disclaimer, Applicant has cancelled apparatus claims 21-26, 28 and 30 (along with apparatus claims 27 and 29, which were not rejected under §102) thereby rendering this rejection moot.

***Claim Rejections under §103***

6. The Examiner has rejected claims 12-20, 27 and 29 under 35 U.S.C. §103(a) as being unpatentable over Lenhardt in view of U.S. Patent No. 5,047,994 to Rastatter et al. (hereinafter, "Rastatter"). In response, in order to advance prosecution, and without prejudice or disclaimer, Applicant has hereby cancels independent method claim 12, dependent method claim 14, and dependent apparatus claims 27 and 29 (thus removing all apparatus claims from the application), and amends dependent method claims 13-20 to depend from new claim 31.

7. Applicant respectfully submits that the rejections of method claims 13 and 15-20 are now moot in view of the above amendments. However, Applicant will briefly explain why the current claims are allowable.

8. Applicant has added new method claim 31, from which claims 13 and 15-20 depend. New claim 31 is directed to a "method of treating stuttering, comprising: fitting a bone conducting hearing apparatus to a user having a stuttering problem but no substantial hearing impairment." (See, Applicant's claim 31, above; emphasis added.) The method further comprises: "receiving, with a microphone of the bone conducting hearing apparatus, sound including a voice of the user, and directing the received user's voice back to the user through the bone conducting hearing apparatus to treat the stuttering problem." (See, Applicant's claim 31, above; emphasis added.)

9. Applicant submits, as detailed below, that neither Lenhardt nor Rastatter expressly or inherently disclose the use of a bone conduction hearing apparatus to treat stuttering. Additionally, Applicant submits that neither of the cited references expressly or inherently disclose the use of a bone conduction hearing apparatus in a person that has no substantial hearing impairment.

10. Lenhardt is directed to a hearing aid comprising a bone conduction device that vibrates at "supersonic" frequencies, to rehabilitate the hearing impairment of a hearing impaired person (such as an elderly person with hearing channels that have deteriorated) to hear better. (See, Lenhardt, abstract.) Lenhardt does not teach or suggest that its teachings are applicable to treating stuttering. Still, the Office Action alleges that Lenhardt "relieve[s] problems associated with stuttering." (Office Action, page 5, lines 1-3.) Apparently, the Office Action asserts that

because the Lenhardt device is allegedly similar to the device disclosed (but now not claimed with the cancellation of all of the apparatus claims) by Applicant, Lenhardt may be used to treat stuttering.

11. It is respectfully submitted that the Office Action has rejected the previously pending method claims for reasons analogous to why the previously pending apparatus claims were rejected. Applicant suspects that the Office Action applied (i) case law holding that a newly discovered utility of an old apparatus does not make the *old apparatus* patentable (even if the apparatus claim recites the intended use for the apparatus) to (ii) a *method* of using an old apparatus<sup>1</sup> in a new way to exploit previously unknown utility.

12. Regarding the method claims, the patent statutes specifically permit patents on a new use for an allegedly old product. In view of this, Applicant requests that the PTO reconsider the method claims afresh, and has cancelled the apparatus claims based on the belief that those claims only serve to distract from the patentability Applicant's invention.

13. Specifically, it is well established that the discovery of a previously unrecognized inherent feature of a known *apparatus* does not impart patentability onto that *apparatus*. In this case, it is assumed *arguendo* that the inherent feature is the ability of a bone conducting device to ameliorate stuttering if so used. However, claim 31 is a *method* claim, not an *apparatus* claim, and Applicant is claiming a use of a bone conducting device to exploit a utility that was previously unrecognized. In this regard, consider one of the landmark cases on inherency, a case that is cited in the MPEP,<sup>2</sup> *In re Rijckaert*. (*In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993), a copy of which is attached in Appendix A.) In *In re Rijckaert*, the Federal Circuit held that

the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown . . . Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.

(*In re Rijckaert* at 1534, citing *In re Sporeman*, (363 F.2d 444 (CCPA 1966) (attached in Appendix B), both cases cited by the Board of Patent Appeals and Interferences for these propositions as recently as 2009. (See, e.g., *Ex Parte Cook*, where the Board distinguishing

<sup>1</sup> Assumed *arguendo* to be the case.

<sup>2</sup> Although cited for a different proposition relating to inherency.

between claims that are the same as the prior art save for latent properties and a rationale to combine/modify based on unrecognized inherent features (Bd.Pat.App. & Interf., 2009) (attached as Appendix C.)

14. Here, the Office Action relies on a feature that will be assumed *arguendo* to be inherent in Lenhardt (that use of Lenhardt might “relieve problems associated with stuttering”) as a rationale to use Lenhardt as the primary reference to reject a method claim directed towards treating stuttering. This is forbidden by *In re Rijckaert*: “Obviousness cannot be predicated on what is unknown . . . Such a retrospective view of inherency is not a substitute for some teaching or suggestion [or properly articulated rationale] supporting an obviousness rejection.” (*In re Rijckaert* at 1534.) Even if Lenhardt inherently has beneficial effects when applied to stutters, to reject as obvious a method of treating stuttering when it was unrecognized that Lenhardt may have such utility if so used does not comport with the just-identified case law. Indeed, the absence in the prior art of a recognition or even a suggestion that Lenhardt could be used to treat stuttering indicates that the Office Action relies on Applicant’s own disclosure as a basis to reject the claims as obvious in view of Lenhardt.

15. Applicant relies on *Catalina Marketing* to further illustrate why the method claims are patentable. (*Catalina Marketing*, 289 F.3d 801 (Fed. Cir. 2002) (attached in Appendix D).) In *Catalina Marketing*, the Federal Circuit articulated a hypothetical scenario where a new use for an old product can be patentable. The court detailed that a method claim to shoe polish used to grow hair may be patentable, as opposed to a claim to a method of using shoe polish to repel water from shoes, where a composition usable for shoe polish was known.<sup>3</sup> (*Catalina Marketing*

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<sup>3</sup> “Perhaps a hypothetical best illustrates these principles: Inventor A invents a shoe polish for shining shoes (which, for the sake of example, is novel, useful, and nonobvious). Inventor A receives a patent having composition claims for shoe polish. Indeed, the preamble of these hypothetical claims recites “a composition for polishing shoes.” Clearly, Inventor B could not later secure a patent with composition claims on the same composition because it would not be novel. Likewise, Inventor B could not secure claims on the method of using the composition for shining shoes because the use is not a “new use” of the composition but, rather, the same use shining shoes. Suppose Inventor B discovers that the polish also repels water when rubbed onto shoes. Inventor B could not likely claim a method of using the polish to repel water on shoes because repelling water is inherent in the normal use of the polish to shine shoes. In other words, Inventor B has not invented a “new” use by rubbing polish on shoes to repel water. Upon discovering, however, that the polish composition grows hair when rubbed on bare human skin, Inventor B can likely obtain method claims directed to the new use of the composition to grow hair. See 35 U.S.C. § 101 (1994); 35 U.S.C. § 101 (1994) (“Whoever invents or discovers any new and useful process . . . may obtain a patent therefor.”); 35 U.S.C. § 100(b) (1994) (“The term ‘process’ means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”). (*Catalina Marketing* at 809-

at 809-10.) Specifically, the use of the shoe polish to grow hair was not “inherent in the *normal use* of the polish to shine shoes.” (*Catalina Marketing* at 810.) Here, the normal use of Lenhardt is to treat hearing loss, and the treatment of stuttering is not inherent in the *normal use* of Lenhardt. That is, just as is the case with the shoe polish of the *Catalina Marketing* hypothetical, even though Lenhardt might be able to be used to treat stuttering, in normal use, it was not so used, and the person of ordinary skill would not have thought that it could so be used.

16. In order to advance prosecution, Applicant has explicitly recited the feature that the bone conduction hearing apparatus is fitted to “a user with a stuttering problem *but no substantial hearing impairment.*” (See, Applicant’s claim 31, above; emphasis added.) Applicant submits that with this recitation, Applicant’s method claim is even more analogous to the hypothetical use of shoe polish to grow hair detailed in *Catalina Marketing*. Claim 31 explicitly forecloses use of the bone conducting hearing apparatus on a hearing impaired person. Lenhardt explicitly teaches that the normal use of the bone conducting hearing aid taught therein is to treat hearing impairments. Accordingly, claim 31, which recites the use of a bone conducting hearing apparatus on a person “without a substantial hearing impairment” is akin to using shoe polish on skin. It is something that is not obvious.

17. Applicant submits that the ordinary artisan, who, as the Supreme Court articulated in *KSR*, is a person of ordinary creativity, and thus not an inventor, would not have thought to utilize a bone conducting hearing apparatus in a person without a hearing impairment. Bone conducting hearing aids are typically intrusive, often using a metal screw inserted through the skin to attach the hearing aid to the skull. The idea of using a bone conductive hearing apparatus to treat stuttering in a person without a hearing impediment is the work of the inventor, not the work of a person with ordinary creativity.

18. The Office Action asserts that “it would have been obvious . . . to have utilized a method for treating stuttering suggested by Rastatter, as a method *for improving the hearing of an individual* as taught by Lenhardt.” (Office Action, page 6, lines 14-18, emphasis added.) With the recitation that the method of claim 31 is practiced on a user without a substantial hearing

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10, citations and quotations omitted except to statute.)

impairment, it would not have been obvious to combine Rastatter with Lenhardt “as a method for improving the hearing of an individual,” as the individual’s hearing would not need to be improved.

19. To the extent that even after taking the above arguments into account, the PTO believes that it can still make out a *prima facie* case of obviousness, Applicant takes this opportunity to preemptively rebut that case based on the fact that Applicant’s invention provides unexpected results in view of the prior art. Specifically, in his application, Applicant explicitly states that “*unexpectedly*, it has now been found that persons with stuttering problems (but no hearing problems) have been helped by using BAHA bone anchored hearing aids.” (Application, page 5, lines 11-15, emphasis added.)<sup>4</sup> With the recitation in claim 31 that the bone conducting hearing apparatus is used to treat stuttering in a person without a substantial hearing impairment, the secondary consideration of unexpected results identified by Applicant is directly linked to the invention of claim 31, and thus must be taken into account by the PTO.

20. Applicant recognizes that secondary considerations, such as unexpected results, are not a panacea to overcoming an obviousness rejection. However, when the secondary considerations are coupled with the above arguments (clearly demonstrating that assuming *arguendo* a case for obviousness can be established, at most, any case of obviousness is close call), the totality of the facts lead to the conclusion that claim 31 is patentable, and thus the secondary consideration of unexpected results rebuts any *prima facie* case of obviousness that may remain after the above arguments are taken into account.

21. Independent claim 36 contains the recitations of claim 31, and is thus allowable for at least the pertinent reasons that render claim 31 allowable, as detailed above.

#### ***Dependent Claims***

22. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the

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<sup>4</sup> MPEP §2141(II), which makes clear that the Supreme Court, in *KSR*, has reaffirmed that secondary considerations are still included in the *Graham* factors, also makes clear that evidence of unexpected results may be included in the specification as filed, as has been done by Applicant in this case.

art of record. Accordingly, Applicant respectfully asserts that the dependent claims are also allowable over the art of record.

***Conclusion***

23. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.
24. Applicant reserves the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicant reserves the right to pursue such claims in a continuation or divisional application.

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